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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,998	06/13/2001	Yoshio Awakura	01316LH	4025

1933 7590 05/21/2003

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/21/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,998

Applicant(s)

AWAKURA ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6-10, 12-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6-10, 12-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

As a means of overcoming the art rejections over Maeda, and in view of the Examiner's indication of allowable subject matter in claims 5 and 15, the Applicant has incorporated the limitations of claims 5 and 15 into claims 6 and 16 respectively.

Although this amendment is sufficient to overcome the standing rejection, the claims are not allowable over the reference cited *infra*.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Each of these claims recites the application of a primer to the soft magnetic powder yet the disclosure has not one single specific chemical example of this component. Typically, in the silicones art, primer materials and coupling agents are both exemplified by silanes, titanates, etc. Therefore, in the absence of any mention of specific materials, it is impossible to determine how the primers of claims 10 and 20 are to be differentiated from the coupling agents of claims 8 and 18. Further, are the primers only to be coated onto the magnetic powder when the coupling agents are not? Applicant cannot even rely on the solubility parameter value as a means of setting apart

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the primer and coupling agent because there is no evidence that the solubility parameter value of the coupling agent, at between 6 and 10, doesn't also have a solubility parameter value below that of the powder but higher than that of the rubber since these values have not been disclosed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 5-9, 12-13, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., U.S. Patent # 6,514,428. Suzuki discloses a composite body that may be employed in electronic equipment as an electromagnetic wave absorbing article. In fact, the composite, by virtue of the inclusion of a heat conductive filler, serves the dual role of shielding against electromagnetic radiation while also conducting thermal energy away from the electronic device.

In its most general embodiment, said composite is comprised of a silicone elastomer that is hydrosilylation curable or peroxide curable, a soft magnetic metal powder which can be made available as flakes (aspect ratio of between 5 and 20 according to column 2, lines 39-41) and round particles (average particle diameter = 0.1 to 50 micrometers) alike, a heat conductive filler, and other conventional additives such as a silane wetter, or coupling agent, for improving dispersion (column 5, lines 50-58).

It is acknowledged that the reference is silent as to the specific surface area of the magnetic materials that are to be incorporated. Indeed, the flakes are described only in terms of the aspect ratio and the length in the long dimension of the flat particle whereas the round particles are disclosed in terms of particle diameter. Nonetheless, it is the position of the Office that one having ordinary skill will appreciate the significant relationship between specific surface area and packing density. That is, one of ordinary skill would immediately recognize that as the specific surface area becomes increasingly large, the filler packing density is lowered. If packing density becomes too low, the silicone matrix is incapable of accommodating enough filler to achieve the desired effect. Therefore, that person would, as a matter of routine experimentation, select fillers having varied specific surface area to identify an optimum filler for this application.

As for claims 3 and 13, platinum is added as a hydrosilylation catalyst where addition-cured rubbers are sought (column 5, lines 11-21). Additionally, copper metal and titania are among the heat-conducting fillers that are contemplated in column 2, lines 63-67.

As for claims 8, 9, 18, and 19, Applicant generally identifies silanes in claims 9 and 19 as being a class of materials having the solubility parameter value recited in claims 8 and 18. It is further noted that the disclosure does not appear to name any specific embodiments of this aspect of the invention. It is, therefore, presumed that all silanes will satisfy the requirement outlined in claims 8 and 18. Thus, Suzuki renders obvious this aspect of the invention despite its similar failure to elaborate on these materials.

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"[P]roducts of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See also *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700